

Election

Applicant elects Group I, claims 1-18 and 27-28. The restriction requirement is traversed as being improper for the following reasons.

Remarks

In order to maintain a restriction requirement, the Examiner has the initial burden of showing:

- (1) that the restricted groups are independent or distinct; and
- (2) that there would be a serious burden on the Examiner if restriction is not required.

M.P.E.P. § 803.01. Applicant respectfully submits that the Examiner has not met the burden of showing that the inventions are either independent or patentably distinct.

The Examiner alleges that Groups I and II are related as subcombinations usable together. The Examiner states that invention I can be used in a local instrument without using the claimed telephone apparatus of invention II and that invention II can be used without the feature of invention I.

Applicant submits that the Examiner's unsupported conclusions are insufficient to meet his burden of showing distinctness. Attention is invited to M.P.E.P. § 806.05(d), which states that "The examiner must show, by way of example, that one of the subcombinations has utility other than in the disclosed combination" (emphasis added). M.P.E.P. § 806.05(d) further states that "The burden is on the examiner to provide an example" (emphasis added). The examiner has not provided, by way of example, any alternative utility for either of the above claim groupings.

Applicant respectfully submits that the restriction requirement is deficient in that it merely concludes that the inventions are patentably distinct without providing an example, as is required by M.P.E.P. 806.05(d) (which, incidentally, is the same section of the M.P.E.P. relied upon by the Examiner in

support of the restriction requirement). The purpose of requiring the examiner to provide an example is to allow the Applicant an opportunity for rebuttal, whereby the Examiner must then either document or otherwise support a viable alternative or withdraw the requirement for restriction. By providing only conclusions without the required supporting example, the Examiner is depriving Applicant of an opportunity to rebut such conclusions. It is unfair to force Applicant to incur the additional time and expense of dividing the invention among multiple applications without at least providing a reasonable example supporting the restriction requirement and allowing Applicant an opportunity for rebuttal. Therefore, it is respectfully requested that the Examiner either support the restriction requirement with an example as required by the M.P.E.P., or, withdraw the restriction requirement and examine claims 20-26 along with the elected claims.

Furthermore, even if the Examiner is able to show an example of an alternative utility, the restriction requirement is still untenable, since there is no serious burden on the Examiner. The Examiner has not demonstrated that there would be a serious burden if the Groups were to be examined together. M.P.E.P. § 803 states that "if the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions" (emphasis added).

In the present case there cannot possibly be a serious burden if the restricted claims 20-26 are examined together with the elected invention since claims 20-26 have already been examined on the merits in the Office action dated October 22, 2002. Thus, even if the claim groupings are distinct, there is no serious burden in examining claims which have already been examined. That the examiner has already examined claim 20-26 on the merits demonstrates a lack of any serious burden, as is required to maintain a restriction requirement.

For the above reasons, it is submitted that the restriction requirement is improper because the Examiner has not met his initial burden of providing supporting examples showing that the present claims are patentably distinct. Also,

the claims sought to be restricted have already been examined on their merits, and thus, the Examiner has not demonstrated any serious burden in examining the entire application. Accordingly, withdrawal of the restriction requirement and examination all claims pending herein, together and in their entireties, is respectfully requested.

Respectfully submitted,



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